

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the following remarks.

Status of Claims

Claims 1, 3-20 and 22-26 are currently pending in the application of which claims 1, 10, 14 and 15 are independent.

In the Office Action mailed July 20, 2009, claims 1, 3-20 and 22-26 were rejected.

No amendments have been made in this Response. Thus, no new subject matter has been introduced to the application.

Summary of the Office Action

Claims 1-4, 9-11, 14, 18-19, 22, and 24 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,598,459 to Haartsen (hereinafter “Haartsen”) in view of European Patent No. EP 1161031A2 to Kimura (hereinafter “Kimura”).

Claims 15-17, 20, and 25 were rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Haartsen in view of U.S. Patent Application Publication No. 2006/0183467 to Stewart et al. (hereinafter “Stewart”).

Claims 5-8, 12, 13, 23, and 25 were rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Haartsen in view of Kimura and in further view of Stewart.

The rejections above are respectfully traversed for at least the reasons set forth below.

Claim Rejections Under 35 U.S.C. §103(a)

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007):

“Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” Quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966).

As set forth in MPEP 2143.03, to ascertain the differences between the prior art and the claims at issue, “[a]ll claim limitations must be considered” because “all words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385. According to the Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of *KSR International Co. v. Teleflex Inc.*, Federal Register, Vol. 72, No. 195, 57526, 57529 (October 10, 2007), once the *Graham* factual inquiries are resolved, there must be a determination of whether the claimed invention would have been obvious to one of ordinary skill in the art based on any one of the following proper rationales:

(A) Combining prior art elements according to known methods to yield predictable results; (B) Simple substitution of one known element for another to obtain predictable results; (C) Use of known technique to improve similar devices (methods, or products) in the same way; (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results; (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success; (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or

to combine prior art reference teachings to arrive at the claimed invention. *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007).

Furthermore, as set forth in *KSR International Co. v. Teleflex Inc.*, quoting from *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006), “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasonings with some rational underpinning to support the legal conclusion of obviousness.”

Therefore, if the above-identified criteria and rationales are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

- **Claims 1-4, 9-11, 14, 18-19, 22, and 24:**

Claims 1-4, 9-11, 14, 18-19, 22, and 24 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Haartsen in view of Kimura. This rejection is respectfully traversed for at least the following reasons.

- **Independent Claim 1:**

- 1. Haartsen in view of Kimura fails to teach or suggest sending a request to the cellular communications service provider for verifying the trustworthiness of the provider of the wireless computer network service.**

Independent claim 1 recites a method for operating a communications device, said method comprising, among other elements, “sending **a request** ... to the cellular communications service provider **for verifying the trustworthiness of the provider of the wireless computer network service**” (emphasis added). Haartsen in view of Kimura fails to teach or suggest this claimed feature for at least the following reasons.

Haartsen discloses a method and system for handing a cell phone over from a wide-area cellular network provider to a local home/office base station (such as a base station for a wireless home or office telephone) when the cell phone enters the local region of the home base station. More specifically, Haartsen shows in Fig. 3B a system having a cellular terminal 120 (hereinafter “cell phone 120”), a wide area cellular network provider 102 having a cell cover area 104, and a base station 110 having a local region 114. In operation, when the cell phone 120 enters the local region 114 of the base station 110, the cellular network 102 detects that the cell phone 120 has entered the local region 114 (See *Haartsen*, col. 7, lines 11-14; step 310 in Fig. 3A). The cellular network 102 then creates a random-code challenge RAND and sends that RAND challenge to the base station 110 via the cell phone 120 to authenticate the base station 110 (col. 7, lines 14-21; step 320 in Fig. 3A; signals RAND 126a and 124a in Fig. 3B). In response, the base station 110 sends an authentication **response** RESP_L (signals 124b and 126b in Fig. 3B) to the cellular network 102 via the cell phone 120 (col. 7, lines 22-33; step 330 in Fig. 3A). The cellular network 102 compares the authentication response RESP_L from the base station 110 with a code RESP_N stored in the cellular network 102 (col. 7, lines 31-33; step 340 in Fig. 3B). If they match, the cellular network 102 hands the cell phone 120 over to the base station 110 (col. 8, lines 15-17; step 350 in Fig. 3B).

Thus, in Haartsen, the cell phone 120 does not send a **request** to the cellular network 102 to verify the trustworthiness of the base station 110, as recited in claim 1. Instead, the cell phone 120 is only a relay for the cellular network 102 and the base station 110 (See *Haartsen*, col. 7, line 34). In the rejection of claim 1, the Office Action asserts that the response signal RESP_L 126b in Fig. 3B from the cell phone 120 to the cellular network 102

is the “request” recited in claim 1 (See *Office Action*, page 3, referring to col. 7, lines 29-33 of Haartsen). However, that assertion in the Office Action is respectfully traversed. The authentication response RESP_L 126b in Fig. 3B going from the cell phone 120 to the cellular network 102 is a not a request, but rather a response, to authenticate the base station 110 (see specifically col. 7, line 30, “base station response RESP_L”). As discussed above, in Fig. 3B of Haartsen, the signal RAND 126a from the cellular network 102 is the request; the signal RESP_L 124b from the base station 110 is the response; and the signal RESP_L 126b from the cell phone 120 is the relayed response from the base station 110 to the cellular network 102. Without the request signal RAND 126a from the cellular network 102, the base station 110 would not have generated the response signal RESP_L. Therefore, it is unreasonable and improper to interpret the response signal RESP_L 126b from the cell phone 120 as a “request”, as asserted in the Office Action.

Accordingly, Haartsen fails to teach or suggest “sending a request ... to the cellular communications service provider for verifying the trustworthiness of the provider of the wireless computer network service,” as recited in claim 1.

Kimura fails to cure the deficiencies of Haartsen. Kimura discloses an access point device for receiving a request from a mobile station (such as a cell phone) to authenticate that mobile station before allowing the mobile station to connect to a wireless LAN (See *Kimura*, the Abstract and paragraph [0017]). Thus, in Kimura, the request sent from the mobile station to the access point device is for authenticating the mobile station, not for authenticating a provider of a wireless LAN or computer network service. Thus, Kimura fails to teach or suggest “sending a request ... to a cellular communications service provider

for verifying the trustworthiness of the provider of the wireless computer network service,” as recited in claim 1.

Accordingly, Haartsen in view of Kimura fails to teach or suggest sending a request to the cellular communications service provider for verifying the trustworthiness of the provider, as recited in claim 1.

2. Haartsen in view of Kimura fails to teach or suggest “receiving an indication of potential use of the wireless hotspot from a user.”

Independent claim 1 also recites “receiving an indication of potential use of the wireless hotspot from a user of the communications device” (emphasis added). In the rejection of claim 1, the Office Action correctly admits that Haartsen fails to disclose this claimed feature (See *Office Action*, page 4, lines 5-6).

The Office Action, however, asserts that Kimura discloses this claimed feature in paragraph [0017]. As discussed above, Kimura discloses an access point device for authenticating a mobile station upon receiving an authentication request from the mobile station (see *Kimura*, paragraph [0017], “first step”). However, Kimura fails to teach or suggest that the authentication request is from the user of the mobile station. Thus, Kimura fails to teach or suggest “receiving a request ... from a user of the communications device” as recited in claim 1. As a result, Kimura fails to cure the deficiencies of Haartsen.

Moreover, even if assuming for the sake of argument that the authentication request in Kimura is from a user of the mobile station, one skilled in the art would still not have been motivated to use the teaching in Kimura to modify Haartsen as suggested in the Office Action. In Kimura, the authentication request is for authenticating the mobile station (such as a cell phone), not for authenticating the provider of a wireless LAN or base station. On the other hand, in Haartsen, the authentication is for the base station 110, not for the cell phone

120 (See *Haartsen*, col. 3, lines 1-3 and col. 6, lines 38-41: “The present invention stems from the realization that it is not the cellular terminal that needs authentication, but rather the telephone base station.”). As such, utilizing Kimura to modify Haartsen as suggested in the Office Action would not work and would be contrary to the teaching of Haartsen.

3. Haartsen fails to teach or suggest a wireless computer network running at a wireless hotspot.

Claim 1 recites “a wireless computer network service provider.” In Haartsen, there is no wireless computer network service provider. Rather, Haartsen relates to a telephone network. The base station 110 is a wired telephone station such as a phone in home or office (See *Haartsen*, col. 1, lines 46-59). There is no teaching or suggestion of a wireless computer network in Haartsen. The rejection of claim 1 fails to point out where the claimed “wireless computer network service provider” is allegedly disclosed in Haartsen. Therefore, Haartsen fails to disclose all of the features recited in claim 1.

Note that the argument above was discussed in the previous Amendment but the Examiner failed to address it in the present Office Action. The Examiner is therefore respectfully requested to address this argument in a subsequent Office Action.

For at least the foregoing reasons, the Office Action has failed to establish that independent claim 1 is *prima facie* obvious in view of the combined disclosures contained in Haartsen in view of Kimura, as proposed in the Office Action. Therefore, withdrawal of the rejection of independent claim 1 and allowance of the claim is respectfully requested.

○ Independent Claims 10 and 14:

Independent claims 10 and 14 recite features similar to those of independent claim 1 as discussed above. Thus, independent claims 10 and 14 are also believed to be allowable over the cited documents of record for at least the same reasons as set forth with respect to

independent claim 1. It is therefore respectfully requested that the rejection of independent claims 10 and 14 be withdrawn, and these claims be allowed.

- Dependent Claims 2-5, 10, 14 and 19:

Claims 2-4, 9, 11, 18-19, 22 and 24 are dependent from one of independent claims 1, 10, and 14. Thus, they are believed to be allowable over the cited documents of record for at least the same reasons set forth above with respect to independent claims 1, 10, and 14 as discussed above. It is therefore respectfully requested that the rejection of claims 2-4, 9, 11, 18-19, 22 and 24 be withdrawn, and these dependent claims be allowed.

- Claims 15-17, 20, and 25

Claims 15-17, 20, and 25 were rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Haartsen in view of Stewart. This rejection is respectfully traversed for at least the reasons set forth below.

- Independent claim 15:

Independent claim 15 recites, among other elements, “determining that the user is within the vicinity of and outside of an operating range of the location-dependent wireless computer network service” (emphasis added). Haartsen in view of Stewart fails to teach this claimed feature for the following reasons.

In the rejection of claim 15, the Office Action correctly admits that Haartsen fails to teach or suggest determining that the use is within the vicinity of and outside of a wireless computer network service, as recited in claim 15 (See *Office Action*, page 11, lines 1-3).

The Office Action asserts, however, that Stewart discloses this claimed feature in its paragraph [0015] and that it would have been obvious to one skilled in the art “to apply the

teaching of Stewart to Haartsen to provide a system which can automatically locate a user with greater precision than is currently available” (See *Office Action*, page 11, lines 4-10). Paragraph [0015] of Stewart discloses a method for using known locations of local area network access points to service mobile users who are in the vicinity of these access points, by (a) detecting the presence of the mobile unit in the vicinity of an access point, and (b) transmitting /receiving information from the mobile unit to/from the network through the access point.

Thus, in Stewart, the “vicinity” of the mobile unit means the mobile unit is still **within the detecting range of the access point** in order for the access point to detect the presence of the mobile unit. In other words, Stewart does not teach detecting the presence of the mobile unit when the mobile unit is outside of the detecting range of the access point. Therefore, Stewart fails to teach or suggest “determining that the user is within the vicinity of **and outside of an operating range** of the location-dependent wireless computer network service,” as recited in claim 15. As a result, the proposed combination of Haartsen in view of Stewart would not have yielded the invention recited in claim 15.

For at least the foregoing reasons, the Office Action has failed to establish that independent claim 15 is *prima facie* obvious in view of the combined disclosures contained in Haartsen in view of Stewart, as proposed in the Office Action. Therefore, withdrawal of the rejection of independent claim 15 and allowance of the claim is respectfully requested.

○ Dependent Claims 16, 17, 20 and 25:

Because claims 16, 17, 20 and 25 depend from independent claim 15, they are believed to be allowable over the cited documents of record for at least the same reasons set forth above with respect to independent claim 15. It is therefore respectfully requested that

the rejection of claims 16, 17, 20 and 25 be withdrawn, and these dependent claims be allowed.

Conclusion

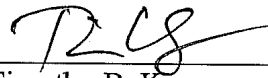
In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

Dated: October 20, 2009

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